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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,234

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Beat O. Blattmann

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GENENCOR INTERNATIONAL, INC.
ATTENTION: LEGAL DEPARTMENT
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EXAMINER

MEAH, MOHAMMAD Y

ART UNIT

PAPER NUMBER

1652

MAIL DATE

DELIVERY MODE

03/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/524,234	Applicant(s) BLATTMANN ET AL.	
	Examiner MD. YOUNUS MEAH	Art Unit 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

The claims 1-19 are pending in the instant office action.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-12, drawn to a modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 26 of the mature *E. coli* phytase designated EBC18B2.

Group II, claim(s) 1-12, drawn to a modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 43 of the mature *E. coli* phytase designated EBC18B2.

Group III, claim(s) 1-12, drawn to a modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 46 of the mature *E. coli* phytase designated EBC18B2.

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Group IV, claim(s) 1-12, drawn to a modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 54 of the mature *E. coli* phytase designated EBC18B2.

Group V, claim(s) 1-12, drawn to a modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 73 of the mature *E. coli* phytase designated EBC18B2.

Group VI, claim(s) 1-12, and 16-18, drawn to a modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 113 of the mature *E. coli* phytase designated EBC18B2.

Group VII, claim(s) 1-2, drawn to a modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 126 of the mature *E. coli* phytase designated EBC18B2.

Group VIII, claim(s) 1-2, drawn to a modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 184 of the mature *E. coli* phytase designated EBC18B2.

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Group IX, claim(s) 1-2, drawn to a modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 228 of the mature *E. coli* phytase designated EBC18B2.

Group X, claim(s) 1-2, drawn to a modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 384 of the mature *E. coli* phytase designated EBC18B2.

Group XI, claim(s) 1-2, drawn to a modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 410 of the mature *E. coli* phytase designated EBC18B2.

Group XII, claim(s) 3-12, drawn to a nucleic acids, vectors and host cells encoding modified phytases and methods of making said phytases wherein said modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 26 of the mature *E. coli* phytase designated EBC18B2.

Group XIII, claim(s) 3-12, drawn to a nucleic acids, vectors and host cells encoding modified phytases and methods of making said phytases wherein modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 43 of the mature *E. coli* phytase designated EBC18B2.

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Group XIV, claim(s) 3-12, drawn to a nucleic acids, vectors and host cells encoding modified phytases and methods of making said phytases wherein modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 46 of the mature *E. coli* phytase designated EBC18B2.

Group XV, claim(s) 3-12, drawn to a nucleic acids, vectors and host cells encoding modified phytases and methods of making said phytases wherein modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 54 of the mature *E. coli* phytase designated EBC18B2.

Group XVI, claim(s) 3-12, drawn to a nucleic acids, vectors and host cells encoding modified phytases and methods of making said phytases wherein modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 73 of the mature *E. coli* phytase designated EBC18B2.

Group XVII, claim(s) 3-12, drawn to a nucleic acids, vectors and host cells encoding modified phytases and methods of making said phytases wherein modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 113 of the mature *E. coli* phytase designated EBC18B2.

Group XVIII, claim(s) 3-12, drawn to a nucleic acids, vectors and host cells encoding modified phytases and methods of making said phytases wherein modified phytase

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having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 126 of the mature *E. coli* phytase designated EBC18B2.

Group XIX, claim(s) 3-12, drawn to a nucleic acids, vectors and host cells encoding modified phytases and methods of making said phytases wherein modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 184 of the mature *E. coli* phytase designated EBC18B2.

Group XX, claim(s)31-12, drawn to a nucleic acids, vectors and host cells encoding modified phytases and methods of making said phytases wherein modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 228 of the mature *E. coli* phytase designated EBC18B2.

Group XXI, claim(s) 3-12, drawn to a modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 384 of the mature *E. coli* phytase designated EBC18B2.

Group XXII, claim(s) 3-12, drawn to a nucleic acids, vectors and host cells encoding modified phytases and methods of making said phytases wherein modified phytase having a modification of a residue within 5 amino acids and/or 6 / of the alpha carbon of residue 410 of the mature *E. coli* phytase designated EBC18B2.

Group XXIII, claim(s) 13-15 and 19, drawn to a methods of modifying a phytase.

The inventions listed as Groups I-XXIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The only shared technical feature of Groups I-XXIII is that they all related to a modified phytase having a modification within 5 residues and/or 6 / of the alpha carbon of residues 26, 43, 46, 54, 73, 113, 126, 184, 228, 384, or 410 of the mature *E.coli* phytase designated EBC18B2. However, this shared technical feature is not a special technical feature as defined by PCT Rule 13.2 as it does not define a contribution over the art. Rodriquez et al. teach modified phytases having mutations at positions A131, V134, D207, and S211 (which correspond to positions 109, 112, 185, and 189, respectively, of the mature *E.coli* phytase designated EBC18B2). Thus the only shared technical feature of Groups I-XXIII is not a special technical feature as defined by PCT Rule 13.2.

4. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.
5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Meah whose telephone number is 571-272-1261. The examiner can normally be reached on 8:30-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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